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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,058	09/19/2003	Stefan J. Rublowsky	PRKR-4500	7284
<div>7590 10/17/2007</div> <div>Philip A. Girard GIRARD & EQUITZ LLP Suite 1110 400 Montgomery Street San Francisco, CA 94104</div> <div>EXAMINER LONEY, DONALD J</div> <div>ART UNIT PAPER NUMBER</div> <div>1794</div> <div>MAIL DATE DELIVERY MODE</div> <div>10/17/2007 PAPER</div>				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/668,058

Applicant(s)

RUBLOWSKY ET AL.

Examiner

Donald Loney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,6-10,12,14 and 19-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4,6-10,12,14,19-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 30, 2007 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 6, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Giulie (4471976).

Giulie teaches a binder strip 12 containing a substrate 19,23 that has a heat activated adhesive 14 thereon. The adhesive has what can be considered grooves where valleys 17 are formed therein (i.e. the section between peaks 16). The grooves appear, from the figures, to be more than 20% the thickness of the adhesive. Refer to figures 1, 3 and 4 along with column 2, lines 27-42. The adhesive extends intermediate the opposite parallel edges on each side of the substrate (i.e. the right and left side).

4. Claims 6, 7, 8, 9, 12 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by DuCorday (4800110).

DuCorday also teaches an elongated strip (spine section 16 of 10) containing a substrate with a heat activated adhesive 26 thereon that contains grooves 34,36 (i.e. deformities). The grooves appear, from the figures, to be more than 20% the thickness of the adhesive. This rejection is being made to specifically address the limitation that the grooves run the length of the strip. The grooves run parallel to the longitudinal axis of intermediate spine section 16. The applicant, due to the use of the open claim language to 'comprising', is not excluding any other section of the strip. It can be seen from applicants' figures 4 and 6a-6C that the prior arts adhesive runs the same direction along the binding. The opposite side of the substrate is substantially smooth in at least some second surface regions per claim 6.

5. Claims 6, 7, 10, 12, 20-23, 26, 28, 29, 33 and 34, 35, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al (4371195).

Wang et al discloses a bonder strip comprising a substrate 19 and a hot-melt adhesive 21,23,24 containing grooves 23b,24b (i.e. mechanical deformalities in the surface of the adhesive). Refer to figure 1 along with column 3, lines 36-64. The adhesive runs the entire length of the strip from top to bottom and is used to connect pages thereto. The deformalities are also disclosed as adding in the adhesive from cold folding and the tendency to spring back are small (i.e. adding in curling thereof). Refer to column 2, lines 26-30. Regarding claims 36-38, a "significant" amount of adhesive is considered not removed and the claims fail to structurally distinguish from the prior art

due to this relative term "significant", since no specific matter of degree is recited. With regards to the substrate being smooth opposite the adhesive, in at least figure 9, the substrates score lines 223 and 224 are not opposite the portion where at least a portion 21 of the adhesive is located.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 2, 4, 6-10, 12, 14 and 19-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applicant's discussion of the prior art (ADPA) in view of either Pogrzeba et al (4247273) or Liland et al (4612230).

The ADPA discloses that binder strips comprising a substrate and hot-melt adhesive are known in the art and that the applicant's invention is in deforming the adhesive in order to prevent curl therein.

Pogrzebra et al teaches that either grooves or indents (punctures as described above) can be formed in a layer in order to prevent a "winged effect" (i.e. curling). This deforming leads to a greater stability in shape of the layer. This is the same reason the applicant is deforming the adhesive layer (i.e. to reduce curl). Refer to figures 3a and 3b along with column 2, lines 41-52. Liland et al discloses punctures 15 formed in the substrate portion of an adhesive tape in order to reduce curl. Refer to figures 1-3 along with column 2, lines 14-18.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the ADPA to form the deformities in the surface of the adhesive, in order to provide greater stability to the layer by preventing curl of the layer motivated by the fact the secondary references teach the deformities reduce curl.

Response to Arguments

10. Applicant's arguments filed July 30, 2007 have been fully considered but they are not persuasive. The applicant argues that one would not look to either Liland or Pogrzeba for providing an anti-curling effect to the instant binder strip. However, since both secondary references teach to deform the surface of a material in order to provide anti-curling thereto one would look to the teachings thereof since this is the same reason the applicant deforms the surface of the adhesive.

11. The Declaration under 37 CFR 1.132 filed December 4, 2007 is insufficient to overcome the rejection of claims 2, 4, 6-10, 12, 14 and 19-39 based upon the applicant's discussion of the prior art (ADPA) in view of either Pogrzeba et al (4247273) or Liland et al (4612230) as set forth in the last Office action because: The Declaration does not state that the work was done in the US/NAFTA/WTO country. Additionally, the Declaration is not commensurate in scope with claims 12, 19, 20 and 22. Claim 12 does not recite anything about the reduced curl as in the Declaration. Claim 19 does not recite anything about the reduced curl and when the grooves were formed (i.e. after cooling of the adhesive) as in the Declaration. Claim 20 does not recite when the grooves were formed (i.e. after cooling of the adhesive) as in the Declaration. Claim 22 appears in direct contrast to the Declaration in that the grooves are recited as formed when the adhesive is in the molten state. The 35 USC 102 rejections above are being maintained since The Declaration does not state that the work was done in the US/NAFTA/WTO country.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Donald J. Loney/
Primary Examiner
Art Unit 1794

DJL:D.Loney
10/16/07